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RICHARD ARON OSSMAN
SCIENCE AND TECHNOLOGY LAW GROUP
75 DENISE DRIVE
HILLSBOROUGH, CA 94010

In re Application of	:
Corey S. Goodman et al	:
Serial No.: 08/971,172	: PETITION DECISION
Filed: November 14, 1997	:
Attorney Docket No.: B98-006-2	:

This is a decision on the petition under 37 CFR 1.181, filed December 11, 2002, requesting the Commissioner to rescind the examiner's Answer, mailed October 1, 2002. The petition has been referred to the Technology Center Director for decision.

BACKGROUND

A review of the file history shows that a restriction requirement was mailed to applicants on September 14, 1998, to which a reply was made on September 18, 1998. A first rejection of the claims was made on March 5, 1999, and a reply thereto made on May 21, 1999 and July 29, 1999. A Final Office action was mailed by the examiner on October 14, 1999, to which a reply was made on November 15, 1999, followed by an interview on December 13, 1999. A new non-final Office action was mailed by the examiner to applicants on January 21, 2000, to which a reply was made on February 16, 2000. A subsequent non-final Office action was mailed to applicants on May 10, 2000, with a reply being filed on September 7, 2000. A third non-final Office action was mailed to applicants on March 27, 2001, regarding which a petition was filed on June 17, 2001, and denied on July 9, 2001. A reply to the Office action was filed on July 17, 2001. A Final Office action was mailed to applicants on October 10, 2001, in response to which a petition was filed on December 14, 2001, and denied on May 1, 2002. A Notice of Appeal was filed on February 11, 2002, as well as an Amendment after Final Office action and a petition, both filed on January 30, 2002. The petition was denied on June 12, 2002, and an Advisory action mailed on June 17, 2002. Applicants' Appeal Brief was filed on July 2, 2002. The examiner mailed an Examiner's Answer to applicants on October 1, 2002. A Reply Brief and this petition were filed on December 16, 2002. The Reply Brief has not yet been considered by the examiner.

The petition also recounts some of the above file history, noting the long pendency, and objects to the Answer on the grounds that it introduces new evidence into the record upon which the examiner relies for maintaining the rejection of the claims. Applicants also assert that the new evidence may not be considered by the Board as applicants have had no opportunity to rebut the new evidence. The "new evidence" allegedly introduced is a e-mail string to support a publication date of a particular sequence applied as prior art.

DISCUSSION

A review of the Final Office action mailed October 10, 2001, the previous non-final Office action, mailed July 9, 2001, the Appeal Brief and the Examiner's Answer has been made. The Examiner's Answer incorporates as part of the text thereof an e-mail string on pages 13-15, the e-mail being dated August 21, 2002. The e-mail incorporates the result of a search of sequence data bases for the date(s) of first availability of specific Genbank Accession numbers, specifically 1825710; 1825711; U88183; and O01632. The e-mail reply equates the first three numbers and gives a date of 2/7/1997 (February 7, 1997) as the date of first availability which is the date shown on the printout of U88183 previously provided applicants. The petition is directed to this e-mail incorporation.

As background for the above incorporation, at least as early as the non-final Office action of July 9, 2001, a rejection of claims 88-90 under 35 U.S.C. 102(a) as unpatentable over Genbank Accession No. U88183, as provided by applicants, having a creation date of 2-14-97 (February 14, 1997) was made. In reply to the first assertion of the U88183 sequence against the claims applicants argued that the sequence was not publicly available until April 21, 1997 (4-21-97), and attempted to establish applicants invention as being prior to this date by means of an affidavit under 37 CFR 1.131. The examiner then provided a new copy of the Accession No. U88183 data, as obtained from Genbank, including the creation and public availability dates, which were not provided in the copy submitted by applicants, as an attachment to Paper No. 29 (the Final Office action of October 10, 2001). The examiner clearly explained how the dates and copy of the sequence were obtained. In the Appeal Brief applicants continued to assert the publication date of 4-21-97 (April 21, 1997) for Accession numbers 1825710 and 1825711 and also U88183 and that applicants had possession of the invention before 4-21-97 based on affidavits submitted under 37 CFR 1.131.

In the examiner's Answer the examiner again asserted the creation and public availability date of U88183 as 2-7-97 and maintained the above rejection as valid. In support thereof, the examiner referred to the previously mailed copy of the U88183 sequence copy obtained from Genbank and provided the e-mail string noted above which confirms the 2-7-97 (note - the copy provided applicant gives 2-14-97 as the date and it is this date that the examiner relies on) public availability date from Genbank itself. The evidence presented only confirms what is contained in the previously printed copy of U88183 provided to applicants and provides a brief explanation of the significance of the release date (public availability date) as provided by Genbank. Thus the e-mail string presented serves merely to confirm again what the examiner had previously asserted with respect to a creation/public availability date for Genbank Accession No. U88183, acknowledged

by applicants as the equivalent of certain sequences set forth in the claims. As noted by the examiner, the only fact in dispute and argued by applicants is the creation/public availability date of the sequences. The e-mail string presents no new facts and no new arguments, but serves only to confirm further the facts already presented by the examiner in the printed copy of the U88183 sequence and disputed by applicants. Equivalent evidence and facts are included with the U88183 sequence listing previously provided applicants. The inclusion of the e-mail string is not "new evidence", but confirmation of facts presented by the examiner (and how they were obtained) and disputed by applicants. Confirmation of an already existing and clearly well-known fact (date of availability, in this instance) by inclusion of its source citation is not considered "new evidence". Applicants have presented no valid reason to strike or rescind the examiner's Answer or any portion thereof.

DECISION

The petition is **DENIED**.

The application will be forwarded to the examiner for consideration of the Reply Brief.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.


Jasmine C. Chambers
Director, Technology Center 1600